

REMARKS

I. PENDING CLAIMS AND SUPPORT FOR AMENDMENTS

Upon entry of the present amendment, claims 88-94 will be pending in this application.

Applicants have amended claim 88 to recite that at least one of R¹, R², R³, R⁴, and R⁵ in Formula IV is not acetyl. Support for this amendment can be found in the disclosure of these substituents as alkanoyl moieties having 2 carbon atoms, which clearly refers to the acetyl group. Applicants have therefore excluded compounds wherein all of the substituents are acetyl, thereby establishing a subgenus that is fully supported by the original specification and claims. *See In re Johnson*, 194 USPQ 187 (CCPA 1977).

Applicants have also added new claim 90, which is limited to the compounds of Formula IV, as amended in claim 88, new claim 91, which requires that at least one of the substituents of Formula IV be other than hydrogen or alkanoyl, and new claim 92, which excludes alkanoyl substituents. Applicants have also added new claims 93 and 94, which are focused on the elected species.

No new matter has been added.

II. THE REQUIREMENT FOR RESTRICTION

The Examiner has made final the restriction requirement made in the Office action dated July 30, 2001 and traversed by Applicants in the response filed January 30, 2002. The Examiner's attempts to answer Applicants' traversal indicate that the Examiner may have misperceived Applicants' position.

The argument addressed by the Examiner is the argument that there is no undue burden on examination, so the Examiner should not require election and should simply

examine the entire scope of the claim at once. Applicants have not made this argument. The argument made by Applicants (and not addressed by the Examiner) is that it is improper to withdraw a portion of a Markush claim from consideration because such a withdrawal is tantamount to a rejection under 35 U.S.C. § 121, which rejection is improper. Applicants further argued that the appropriate procedure for the Examiner to follow where she believes a Markush group to contain patentably distinct inventions is clearly set forth in MPEP § 803.02, i.e., to examine the elected species and if that elected species is found to be patentable, to search the remainder of the Markush claim to the extent necessary to determine its patentability.

The portion of the MPEP quoted by the Examiner does not make this procedure optional when the Examiner determines that there are “too many” compounds and the search of the claim presents an undue burden. To the contrary, the MPEP § 803.02 procedure is to be followed UNLESS the Examiner determines there is no undue burden imposed by the presence of the multiple species, in which case the Examiner is to examine the entire claim without making or giving effect to the election. In short, allegations that the claims impose an undue burden is a prerequisite for requiring election in the first place; it is not sufficient for the Examiner to ignore MPEP § 803.02 and, effectively, reject the claims under 35 U.S.C. § 121.

The Examiner’s arguments that such a withdrawal of a portion of the claims is sanctioned by the cases cited by Applicants is also incorrect. The Examiner’s reasoning is that if the claim lacks unity of invention, then it is proper for the Examiner to withdraw a portion of the claim from consideration. How the Examiner reached this conclusion based on a reading of the cited cases is difficult to understand. Nowhere do either of the cases

provide for such an exception. "Lack of unity", also known as "patentable distinctness" is the other prerequisite for requiring election in the first place. Moreover the cited cases both contained claims where unity must have been lacking, or the restriction would have been found improper on this basis alone. Yet in both cases, the court found that it was improper to withdraw a portion of the claim from consideration. In *Weber*, after explaining that requiring an applicant to divide up of a claim and present it in different applications was tantamount to a rejection because that claim would never be considered on its merits, the court stated:

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be "independent and distinct." It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular *claim* on that same basis. . . . We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses.

In re Weber, 198 USPQ 328, 331-32 (1978).

Applicants again respectfully request that the Examiner reconsider the restriction of the claims into separate groups, and instead treat the claims under MPEP § 803.02, as required by law and PTO policy. If the Examiner continues to treat her requirement as a restriction requirement, rather than an election of species requirement, then Applicants respectfully request that the Examiner fully answer the above points of argument, so that Applicants will be able to take other appropriate action.

III. ANTICIPATION REJECTION OVER NODA ET AL.

In paragraph 5 of the Office action, the Examiner has rejected claim 88 as anticipated under 35 U.S.C. § 102(b) by Noda et al. (U.S. Patent No. 4,395,405). Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

The Examiner asserts that the disclosure in Example 4 of Noda et al. of the compound D-fructopyranose- β -1,3,4,5-tetraacetate, used as a starting material to form the alkyl ketohexopyranoside derivatives disclosed by Noda et al. However, the tetraacetate has every hydroxyl group acetylated. The claimed compound of Formula IV recites that at least one hydroxyl group is not acetylated. Accordingly, there is no anticipation, and the Examiner's rejection should be withdrawn.

IV. THE ANTICIPATION REJECTION OVER SWIDERSKI ET AL.

In paragraph 6 of the Office action, the Examiner has rejected claim 88 as anticipated under 35 U.S.C. § 102(b) by Swiderski et al. (Chemical Abstracts 69:52429). Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

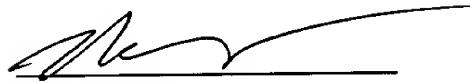
As with Noda et al., Swiderski et al. disclose a fructopyranose pentaacetate. The claims recite that at least one substituent must be different from acetyl. Accordingly, there is no anticipation, and the Examiner's rejection should be withdrawn. Applicants note that there is no utility disclosed for the fructopyranose pentaacetate disclosed in Swiderski et al.

Applicants submit that, in view of the withdrawal of the outstanding rejections, the Examiner should extend the scope of her examination to the extent necessary to determine the allowability all of the claims.

If the Examiner has any questions or comments about this application or about the invention, or if further issues remain to be resolved, she is invited to contact the undersigned at 404.815.6218 prior to the issuance of any final rejection.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Order Account No. 11-0855.

Respectfully submitted,



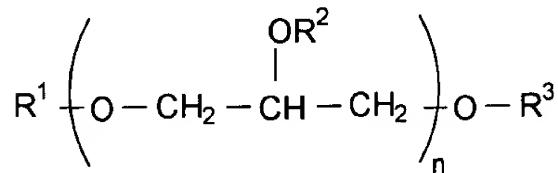
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MARKED UP COPY OF AMENDED CLAIMS

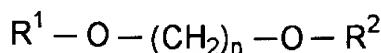
88. (Amended) A compound having a structure selected from the group consisting of:

II:



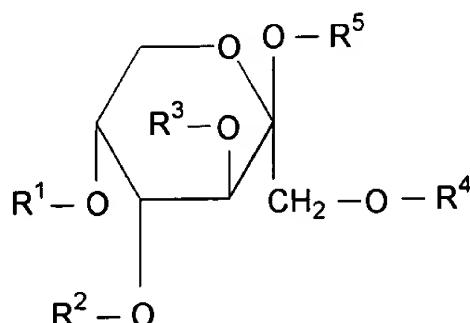
wherein R^1 , R^2 , and R^3 are independently selected from the group consisting of hydrogen, alkanoyl having 2 to 6 carbons, hydroxy-substituted alkanoyl having 2 to 6 carbons, and acyloxy-substituted alkanoyl having 2 to 6 carbons, wherein n is between 1 and 20, and wherein at least one of R^1 , R^2 , and R^3 is other than hydrogen;

III:

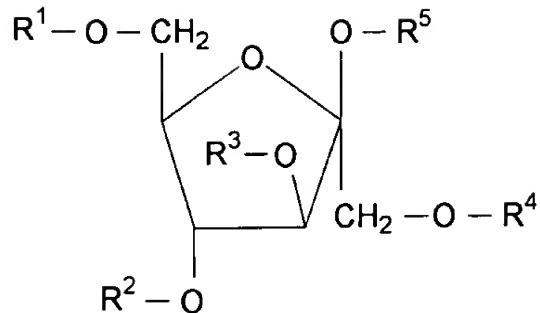


wherein n is an integer between 4 and 8, and R^1 and R^2 are independently selected from the group consisting of hydrogen, alkanoyl having 2 to 6 carbons, hydroxy-substituted alkanoyl having 2 to 6 carbons, and acyloxy-substituted alkanoyl having 2 to 6 carbons, and wherein at least one of R^1 and R^2 is other than hydrogen;

IV:

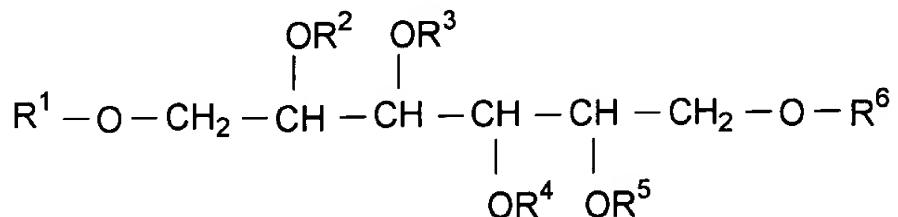


V:

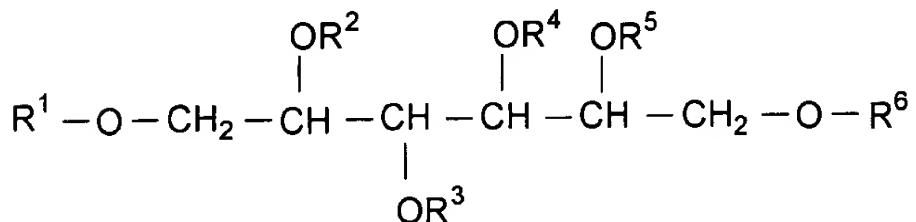


wherein R^1 , R^2 , R^3 , R^4 , and R^5 are independently selected from the group consisting of hydrogen, alkanoyl having 2 to 6 carbons, hydroxy-substituted alkanoyl having 2 to 6 carbons, and acyloxy-substituted alkanoyl having 2 to 6 carbons, and wherein at least one of R^1 , R^2 , R^3 , R^4 , and R^5 is [other than] not hydrogen and is not acetyl;

VI:

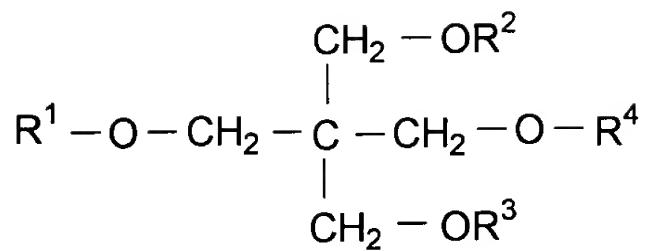


VII:



wherein R^1 , R^2 , R^3 , R^4 , R^5 , and R^6 are independently selected from the group consisting of hydrogen, alkanoyl having 2 to 6 carbons, hydroxy-substituted alkanoyl having 2 to 6 carbons, and acyloxy-substituted alkanoyl having 2 to 6 carbons, and wherein at least one of R^1 , R^2 , R^3 , R^4 , R^5 , and R^6 is other than hydrogen;

VIII:



wherein R^1 , R^2 , R^3 , and R^4 are independently selected from the group consisting of hydrogen, alkanoyl having 2 to 6 carbons, hydroxy-substituted alkanoyl having 2 to 6 carbons, and acyloxy-substituted alkanoyl having 2 to 6 carbons, and wherein at least one of R^1 , R^2 , R^3 , and R^4 is other than hydrogen.